

Customer No. 24498  
Attorney Docket PU030124  
Final Office Action Date: November 5, 2008

### **Remarks/Arguments**

Claims 1-21 are pending in this application, and are rejected in the final Office Action of November 5, 2008. Claim 1 is amended herein to more particularly point out and distinctly claim the subject matter Applicants regard as the invention.

#### **Re: Rejection of Claims 1-7 under 35 U.S.C. §101**

Claims 1-7 are rejected under 35 U.S.C. §101 as allegedly not falling into one of the four statutory categories of invention. Applicant respectfully traverses this rejection for at least the following reasons. Independent claim 1 is amended herein to clarify that the claimed steps are performed using a "digital audio data player". In view of this amendment, claims 1-7 are deemed statutory under 35 U.S.C. §101, and withdrawal of the rejection is respectfully requested.

#### **Re: Rejection of Claims 1-5, 8, 10-13, 15 and 17-20 under 35 U.S.C. §103(a)**

Claims 1-5, 8, 10-13, 15 and 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,987,221 issued to Platt (hereinafter, "Platt") in view of U.S. Patent No. 7,046,588 issued to Heo (hereinafter, "Heo"). Applicants respectfully traverse this rejection for at least the following reasons.

At the outset, Applicants first note that the claimed invention addresses the problem of how to create a playlist using a digital audio data player. To this end, the solution defined by independent claim 1 provides a method of compiling a playlist of digital audio data files using a digital audio data player. The method comprises the steps of:

"enabling a user to select a set of digital audio data files for potential inclusion in the playlist;

enabling the user to determine which of the selected digital audio data files will be included in the playlist by sequentially playing an audio clip from each one of the selected digital audio data files and detecting whether a user input is received while each audio clip is being played; and including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting

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the user input while the currently playing audio clip is being played."  
(emphasis added)

As indicated above, independent claim 1 defines a method of compiling a playlist of digital audio data files, including the step of enabling a user to select a set of digital audio data files for potential inclusion in the playlist. The method then enables the user to determine which of the selected digital audio data files will be included in the playlist by sequentially playing an audio clip from each one of the selected digital audio data files and detecting whether a user input is received while each audio clip is being played. Identifying data for the digital audio data file associated with a currently playing audio clip is included in the playlist in response to detecting the user input while the currently playing audio clip is being played. Independent claims 8 and 15 recite subject matter similar to independent claim 1.

Neither Platt nor Heo, whether taken individually or in combination, teaches or suggests all of the elements of independent claims 1, 8 and 15. On page 5 of the final Office Action dated November 5, 2008, the Examiner admits that Platt fails to teach "[a] method including **sequentially playing an audio clip from each one of the selected audio data files.**" (emphasis original). In an attempt to remedy this admitted deficiency of Platt, the Examiner relies on Heo.

In response, Applicants submit that Heo is unable to remedy all of the deficiencies of Platt. In particular, Heo discloses a method and apparatus that allows users to highlight a portion of an audio track as a representative portion of the audio track. These highlighted portions may then be reproduced in a sequence (see, for example, FIG. 4B). However, as previously pointed out in Applicants' last response, Heo fails to disclose or suggest, *inter alia*, that audio data files are sequentially played to enable a user to determine which audio data files will be included in a playlist, as claimed. As such, the proposed combination of Platt and Heo fails to disclose or suggest, *inter alia*, the steps of "enabling the user to determine which of the selected digital audio data files will be included in the playlist by sequentially playing an audio clip from each one of the selected digital audio data files and detecting whether a user

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input is received while each audio clip is being played" or "including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played", as recited for example by independent claim 1.

In fact, the Examiner ostensibly admits at least one of the aforementioned deficiencies of the proposed combination on page 21 of the final Office Action dated November 5, 2008 by stating "Heo and Platt each fail to teach the detection of a user input specifically at the time of media file playback". That is, the Examiner admits that neither Platt nor Heo discloses "enabling the user to determine which of the selected digital audio data files will be included in the playlist by sequentially playing an audio clip from each one of the selected digital audio data files and detecting whether a user input is received while each audio clip is being played" or "including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played" (emphasis added), as recited for example by independent claim 1. This result is not surprising given that only one of these two references, namely Platt, even addresses the problem of how to create a playlist using a digital audio data player, as claimed. Heo does not even recognize this problem, but instead is directed towards solving a problem of how to customize an "intro function" of a digital audio player (see, for example, column 1, lines 27-59). Accordingly, for at least the foregoing reasons, Applicants submit that neither Platt nor Heo, whether taken individually or in combination, teaches or suggests all of the elements of independent claims 1, 8 and 15. For this reason alone, the instant rejection should be withdrawn.

Moreover, notwithstanding the foregoing arguments, Applicants further submit that one of ordinary skill in the art would have absolutely no motivation to modify Platt using the cited teachings of Heo since the express teachings of Platt teach away from such a modification. In particular, one of Platt's main objectives is to provide a technique which "reduces effort and time required by a user to generate a playlist ... [so that] the user is not required to manually search through a collection of media items and

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select those items that meet the user's current mood or desire in order to generate a playlist." Platt achieves this objective "by automatically generating a playlist based on seed items" (see column 2, lines 30-36 of Platt).

The Examiner's proposed modification to Platt using the cited teachings of Heo would directly defeat the aforementioned objective of Platt since it would necessarily require a user to "manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist." That is, the proposed combination of Platt and Heo as suggested by the Examiner would necessarily require a user to sequentially listen to a number of audio clips and provide user inputs while those audio clips are being played in order to generate a playlist. In this manner, the proposed combination of Platt and Heo would necessarily require a user to "manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist" and thereby defeat Platt's solution of "automatically generating a playlist based on seed items" (see again column 2, lines 30-36 of Platt). As such, one of ordinary skill in the art would have absolutely no motivation to modify Platt using the cited teachings of Heo since Platt expressly teaches away from such a modification.

On page 22 of the final Office Action dated November 5, 2008, the Examiner attempts to support the basis of the proposed combination by alleging:

"[The] combination of Platt and Heo flows from a silence on the part of Platt regarding operative characteristics of the media player of Platt: Figure 4 ... [namely] Platt is silent on the operation of his media player when a user may want to select a plurality of files for potential inclusion into a playlist." (emphasis added)

In response, Applicants note that Platt is not silent on the aforementioned issue. Rather, Platt expressly teaches that a user may manually add a selected track to a playlist by pressing an add button 450 (see, for example, FIG. 4 and column 6, lines 40-42). However, as indicated above, this manual type of track selection (which is completely different than the claimed invention) is not Platt's preferred technique for

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generating a playlist. As such, the Examiner's alleged basis for combining Platt and Heo is directly contrary to the express teachings of Platt.

Accordingly, for at least the foregoing reasons, Applicants submit that independent claims 1, 8 and 15 are non-obvious over the proposed combination of Platt and Heo, and withdrawal of the rejection is respectfully requested.

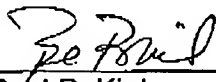
**Re: Claims 6, 7, 9, 14, 16 and 21**

Claims 6, 7, 9, 14, 16 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Platt in view of Heo, and further in view of U.S. Patent Publication No. 2002/0116476 by Eyal et al. (hereinafter, "Eyal"). Applicants respectfully traverse this rejection since Eyal is unable to remedy the deficiencies of Platt and Heo explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

**Conclusion**

In view of the foregoing remarks/arguments and accompanying amendments, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled. Please charge the fee for the RCE to Deposit Account 07-0832.

Respectfully submitted,

  
By: Paul P. Kiel  
Reg. No. 40,677  
Phone (609) 734-6815

Date: 1/22/09  
Patent Operations  
Thomson Licensing LLC  
P.O. Box 5312  
Princeton, New Jersey 08540